

|                               |                        |                     |  |
|-------------------------------|------------------------|---------------------|--|
| <b>Notice of Allowability</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                               | 10/646,758             | ISHIZAKI ET AL.     |  |
|                               | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                               | Yong D Pak             | 1652                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 1/20/2004.
2. ☒ The allowed claim(s) is/are 18-37.
3. ☒ The drawings filed on 19 February 2002 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☒ Certified copies of the priority documents have been received in Application No. 09/856,486.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date <u>8/25/2003</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                    |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                                | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance   |
|   | 9. <input type="checkbox"/> Other _____.   |

Art Unit: 1652

### **DETAILED ACTION**

This application is a divisional of 09/856,486, issued as U.S. Patent No. 6,756,219, which is a 371 of PCT/JP99/06844.

The amendment filed on August 25, 2003, canceling claims 1-17 and adding claims 18-43, has been entered.

Claims 18-43 are pending. Claims 38-43 are withdrawn. Claims 18-37 are under consideration.

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 18-37, drawn to polynucleotide encoding a phospholipase A2, vector comprising said polynucleotide, host cell comprising said polynucleotide and a method of making a phospholipase.

Group II, claim(s) 38-39, drawn to an antibody against a phospholipase A2 and a diagnostic kit.

Group III, claim(s) 40, drawn to a method of detecting a phospholipase A2 related disease by using the antibody of Group II.

Group IV, claim(s) 41, drawn to a method of treating a phospholipase A2 related disease with the antibody of Group II.

Group V, claim(s) 42, drawn to a method of identifying a compound which inhibits phospholipase A2 activity.

Art Unit: 1652

Group VI, claim(s) 43, drawn to a compound which inhibits phospholipase A2 activity.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The products of Groups I, II and VI do not share a special common structural or functional feature. The product of Group I is composed of purine and pyrimidine units, the product of Group II is composed of amino acids and the product of Group VI can be composed of any chemical structure. Also, the products of Groups I, II and VI all have different function. Further, the polynucleotide of Group I will not encode the antibody of Group II, and the antibody of Group II cannot be encoded by the polynucleotide of group I. The methods of Groups III-V do not use the same reagents or produce the same results. Accordingly, Groups I-VI are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

Searching more than one of Groups I-VI would represent a burden on the Office. The search for Groups I-VI is not co-extensive. A search of Group I would not overlap the search for Groups II, V or VI. A search of Group II would not overlap the search of Groups III and IV. A search of Group VI would not overlap the search of Group V. Therefore, searching Groups I-VI would be a serious burden on the Office.

During a telephone conversation with Mr. Cunningham on January 12, 2005 a provisional election was made with traverse to prosecute the invention of Group I,

Art Unit: 1652

claims 18-37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 38-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on August 25, 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Drawings***

Drawings submitted in this application are accepted by the Examiner for examination purposes only.

#### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided

Art Unit: 1652

by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Cunningham on February 2, 2005.

The application has been amended as follows:

**IN THE SPECIFICATION:**

On page 1, line 2,

After "allowed", insert -- as U.S. Patent No. 6,756,219 --

**IN THE CLAIMS:**

In claim 18, line 1

Replace "A" with -- An isolated --

In claim 21, line 2

After "SEQ ID NO:27", insert --, wherein said polypeptide has phospholipase A2 activity --

In claim 22, line 2

After "SEQ ID NO:27", insert --, wherein said polypeptide has phospholipase A2 activity --

In claim 23, line 2

Replace "SD" with --Shine Delgarno --

In claim 27, line 1

Replace " comprising" with -- transformed with --

Cancel claims 38-43.

***Allowable Subject Matter***

Claims 18-37 are allowed.

The following is an examiner's statement of reasons for allowance:

A search in the prior art revealed no suggestion of a polynucleotide encoding a polypeptide having the amino acid sequence of SEQ ID NO:27 nor a polynucleotide hybridizing to SEQ ID NO:26 under stringent conditions as defined in claim 18 and encoding a polypeptide having phospholipase A2 activity. Therefore, the polynucleotide hybridizing to SEQ ID NO:26 under stringent conditions as defined in claim 18 and encoding a polypeptide having phospholipase A2 activity are novel and non-obvious over the prior art.

Art Unit: 1652

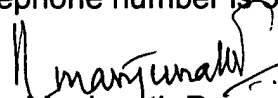
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 571-272-0935. The examiner can normally be reached 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Yong D. Pak  
Patent Examiner 1652

  
Manjunath Rao  
Primary Examiner